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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/194,773	03/31/99	GRASER	T 10191/899

RICHARD L MAYER KENYON & KENYON ONE BROADWAY NEW YORK NY 10004	IM62/1010	EXAMINER
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FIORILLA, C

ART UNIT	PAPER NUMBER
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1731

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DATE MAILED:

10/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/194,773	Applicant(s) Graser et al.
	Examiner Christopher A. Fiorilla	Group Art Unit 1731

Responsive to communication(s) filed on Jul 24, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- Claim(s) 13-24 _____ is/are pending in the application.
 Of the above, claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 13, 14, and 24 _____ is/are rejected.
- Claim(s) 15-23 _____ is/are objected to.
- Claims _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been
- received.
 - received in Application No. (Series Code/Serial Number) _____.
 - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- *Certified copies not received: _____
- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 13,14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurishita et al. (5,144,249) in view of Nenadic et al. (5,871,313) for the reasons as set forth in the previous office action.

3. Applicant's arguments filed July 24, 2000 have been fully considered but they are not persuasive.

With respect to the rejection of the claims under 35 USC 103 applicants argue:
Claim 13 recites, in part, the step of blunting before sintering. Applicants respectfully submit that Kurishita does not teach or suggest the step of blunting before the

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step of sintering. In fact, Kurishita describes an act of chamfering after the oxygen sensor element is fully formed, presumably after sintering. Accordingly, Kurishita teaches away from the above recited element as set forth in claim 13.

This argument is not persuasive. The examiner recognized that the feature of chamfering before sintering was not taught by Kurishita et al. and cited a secondary reference to teach this feature. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The examiner maintains that the above recited element [blunting before sintering] is satisfied by Nenadic. In support, the Examiner cites, out of context, col. 1, lines 65-67. Applicants respectfully draw the attention of the examiner to col. 5, lines 14-23, which further qualify the examiner's citation. In Nenadic, the self-aligning chamfer apparatus includes a cutter apparatus 10 with a heater element 90 provided proximally to blades 116. The heater element 90 provides heat locally to minimize the delamination problem associated with green chamfering methods. Thus, in reality, the heater element 90 is providing a sintering function concurrently with the chamfering. Accordingly, Nenadic does not teach or suggest the above-recited element as set forth in claim 13.

This argument is not persuasive. Applicants' allegation that in reality, the heater element is providing a sintering function concurrently with the chamfering is inaccurate. The heating is believed to soften the binder which allow larger shavings during chamfering. The heating is not conducted at a high enough temperature for sintering. In col. 5, lines 23-28 it recites:

Another benefit of applying heat is that the heat facilitates creation of larger shavings which are more readily removed away from the substrate during a chamfering operation.

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Creation of larger shavings reduces the chances of particulate debris or fused ceramic when the chamfered substrate is subsequently sintered.

The phrase “subsequently sintered” clearly indicates that sintering does not take place during the heating.

Moreover, even assuming Nenadic teaches the step of blunting before sintering, Applicants respectfully submit that Nenadic is improperly combined with Kurishita which teaches away from Nenadic, as interpreted by the examiner, and the above recited element as set forth in claim 13.

This argument is not persuasive. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller* 208 USPQ 871, 881; *In re Sernaker* 217 USPQ 1. It is submitted that the combination of references would have suggested to one skilled in the art that the chamfering method of Nenadic et al. is better since it is the most cost effective (col. 1, lines 65-67).

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Claims 15-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Fiorilla, whose telephone number is (703) 308-0674. The examiner can normally be reached Monday through Friday from 9:00 am to 5:30 pm.

If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached at (703) 308-3837.

Official after final faxes should be sent to (703) 305-3599. All other official faxes should be sent to (703) 305-7718. Unofficial faxes should be sent to (703) 305-7115.

Any inquiry of a general nature or relating to the status of the application should be directed to the group receptionist whose telephone number is (703) 308-0651.



Christopher A. Fiorilla
Primary Examiner
Technology Center 1700
Art Unit 1731